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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,206	04/05/2001	John D' Elia	1533.1100001/MAC/DJN	2584
28393	7590	10/15/2004		
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVE., N.W. WASHINGTON, DC 20005				
EXAMINER RAO, MANJUNATH N				
ART UNIT		PAPER NUMBER		
1652				

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/826,206

Applicant(s)

D' ELIA, JOHN

Examiner

Manjunath N. Rao, Ph.D.

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1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-14, 17-39.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit: 1652

***Advisory Action***

Claims 1-14, 17-39 are now currently pending in this application.

Applicant's request for reconsideration filed on 9-1-04 has been considered and ENTERED. However, the claims are still not in condition for allowance for the following reasons.

In response to the final rejection, applicants have cancelled claims 40-43 which overcomes the rejection of said claims under 35 U.S.C. 112, 1<sup>st</sup> paragraph. Applicants have amended claims 27 and 28 which are now entered. However, applicants have traversed the rejection of claims under Double Patenting rules arguing that no such double patenting issue exists between the claims of the instant application and the issued patent US 6,503,748. Applicants argue that it was only SEQ ID NO:2 in the instant application that is identical to SEQ ID NO:1 claimed in the above patent and that SEQ ID NO:2 is not claimed in the instant application. Applicants also submit that instant claims are drawn to "replicons" and the claims in the above patent never mention "replicons". Examiner respectfully disagrees. This is because claim 1 of the instant application is drawn to "an isolated or purified nucleic acid molecule comprising a polynucleotide having the nucleotide sequence of a *Ketogulonigenium* plasmid replicon found on the endogenous plasmid contained in Deposit No. B-30035" as is claim 1 of the patent. The function of the polynucleotide of claim 1 of the issued patent is inherent in it (replicon). Therefore limitations of the instant claim 1 is encompassed in the claim 1 of the patent. Furthermore, applicant's argument that SEQ ID NO:1, 3 and 4 of the instant application are different from SEQ ID NO:1 of the issued patent is highly misplaced. This is because claims 2, 3 and 4 of the instant application all recite "comprising"

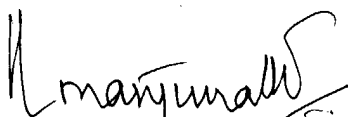
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language and even if applicant amended these claims to recite "consisting of" language, said claims would continue to be obvious over claim 1 of the issued patent. Therefore, contrary to applicant's argument, Examiner reiterates that the Double patenting issue exists and maintains the Double Patenting rejection.

***Conclusion***

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306/9307 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



Manjunath N. Rao, Ph.D.  
Primary Examiner  
Art Unit 1652

October 5, 2004